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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/848,931

05/19/2004

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BJA.0002C1US

5716

21906 7590 02/19/2009  
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EXAMINER

VAN HANDEL, MICHAEL P

ART UNIT

PAPER NUMBER

2424

MAIL DATE

DELIVERY MODE

02/19/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/848,931	<b>Applicant(s)</b> RASHKOVSKIY ET AL.	
	<b>Examiner</b> MICHAEL VAN HANDEL	<b>Art Unit</b> 2424	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-19 and 31-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-19, 31-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Amendment***

1. This action is responsive to an Amendment filed 11/20/2008. Claims **1-4, 6-19, 31-47** are pending. Claims **1, 4, 11, 31, 36, and 44** are amended. Claims **5, 20-30** are canceled. The examiner hereby withdraws the objections to claims **4, 36, and 44** in light of the amendments.

### ***Response to Arguments***

1. Applicant's arguments regarding claims **1, 11, and 31**, filed 11/20/2008, have been fully considered, but they are not persuasive.

Regarding claims **1, 11, and 31**, the applicant argues that Arsenault et al. does not disclose analyzing the content to identify a location to insert the advertisement within the content and, based on said analysis, finding a place to insert said advertisement in said portion. The examiner respectfully disagrees. Arsenault et al. discloses that, based on the intended use of additional material 172 and advertising 174 for playback of cached program 170, CPU 74 organizes and retrieves respective data packets from additional cache memory 92 in appropriate order (col. 18, l. 1-5). This is illustrated in Figure 8, where the transmission stream is received as illustrated at 160, but played back in accordance with playback options 162, 164, 166, or 168 based on the intended use of the additional material and advertising (Fig. 8). The examiner interprets organizing and retrieving the data packets from cache memory in appropriate order based on the intended use of the additional material and advertising as "analyzing the content to

Art Unit: 2424

identify a location to insert the advertisement within the content and, based on said analysis, finding a place to insert said advertisement in said portion,” as currently claimed.

Regarding Applicant’s request to defer the provisional double patenting rejection, the examiner notes that when the examiner becomes aware of two copending applications that would raise an issue of double patenting if one of the applications became a patent, the courts have sanctioned the practice of making Applicant aware of the potential double patenting problem by permitting the examiner to make a “provisional” rejection on the ground of double patenting. The “provisional” double patenting rejection should continue to be made by the examiner in each application as long as there are conflicting claims in more than one application unless that “provisional” double patenting rejection is the only rejection remaining in at least one of the applications (see MPEP 804 I.B.).

### ***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Art Unit: 2424

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims **1-4, 6-19, 31-47** are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims **20-49** of copending Application No. 09/561,443. Although the conflicting claims are not identical, they are not patentably distinct from each other, because they are obvious variations of claims **20** and **37** or are variations of claims that depend therefrom.

Claims **1, 11, and 31** of the instant application correspond to claims 28 and 43 of the ‘443 application, where claim 1 recites a method corresponding to the system of claim 28 and claim 11 recites a method performed by instructions executed by a processor-based system corresponding to claim 28. Claim 31 differs from claim 37 of the ‘443 application in that it recites that the content includes “an interruptible content portion.” Claim 43, which depends from claim 37, recites that the receiver parses instructions for determining when said content may be interrupted. Thus, it is inherent to claim 43 that the content contains an interruptible content portion, since it determines when the content may be interrupted. Claim 31 also differs in that it recites outputting “for display, said portion with an inserted advertisement.” Claim 46, which depends from claim 37, recites finding a place to insert the advertisement in the content in the cache, such that thereafter “the display of content is terminated, followed by display of the advertisement, followed by resumption of the display of content.” Thus, it is inherent to claim 46 that the portion with an inserted advertisement is output for display. As such, the examiner concludes that claim 31 is an obvious variation of claim 37 of the ‘443 application, given the limitations recited in claims dependent on claim 37.

Art Unit: 2424

Claim **3** of the instant application corresponds to claim 21 of the '443 application.

Claim **4** of the instant application corresponds to claim 25 of the '443 application.

Claim **6** of the instant application corresponds to claim 26 of the '443 application.

Claim **7** of the instant application corresponds to claim 42 of the '443 application.

Claim **8** of the instant application corresponds to claim 43 of the '443 application.

Claim **9** of the instant application corresponds to claim 22 of the '443 application.

Claim **10** of the instant application corresponds to claim 29 of the '443 application.

Claim **13** of the instant application corresponds to claim 21 of the '443 application.

Claim **14** of the instant application corresponds to claim 25 of the '443 application.

Claim **15** of the instant application corresponds to claim 26 of the '443 application.

Claim **16** of the instant application corresponds to claim 27 of the '443 application.

Claim **17** of the instant application corresponds to claim 28 of the '443 application.

Claim **18** of the instant application corresponds to claim 22 of the '443 application.

Claim **19** of the instant application corresponds to claim 29 of the '443 application.

Claim **32** of the instant application corresponds to claim 21 of the '443 application.

Claim **33** of the instant application corresponds to claim 38 of the '443 application.

Claim **34** of the instant application corresponds to claim 39 of the '443 application.

Claim **35** of the instant application corresponds to claim 40 of the '443 application.

Claim **36** of the instant application corresponds to claim 41 of the '443 application

(where it is well-known within the prior art that a shell provides an interface for performing the desired function).

Claim **37** of the instant application corresponds to claim 26 of the '443 application.

Art Unit: 2424

Claim **38** of the instant application corresponds to claim 42 of the ‘443 application.

Claim **39** of the instant application corresponds to claim 43 of the ‘443 application.

Claim **40** of the instant application corresponds to claim 29 of the ‘443 application (where it is well-known within the prior art that a shell provides an interface for performing the desired function).

Claim **41** of the instant application corresponds to claim 44 of the ‘443 application.

Claim **42** of the instant application corresponds to claim 45 of the ‘443 application (where it is well-known within the prior art that a shell provides an interface for performing the desired function).

Claim **43** of the instant application corresponds to claim 32 of the ‘443 application.

Claim **46** of the instant application corresponds to claim 46 of the ‘443 application.

Claims **2** and **12** are obvious variations of the ‘443 application, because receiving content over a broadband distribution system is well known within the prior art, as disclosed by U.S. Patent No. 6,971,119 to Arsenault et al. Such a modification is desirable in order to increase the information-carrying capacity of an information channel.

Claims **44**, **45**, and **47** are obvious variations of the ‘443 application, because detecting a pause in the display of content and inserting an advertisement in response to the pause is well known within the prior art, as disclosed by U.S. Patent No. 7,017,173 to Armstrong et al. Such a modification is desirable in order to put “freeze frame” or other similar display imagery to greater uses (Armstrong et al. col. 1, l. 63-67).

NOTE: This is a provisional obviousness-type double patenting rejection.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims **1-3, 6, 7, 10-13, 15, 16, 19, 31, 32, 37, 38, 40, 42, 43, 46** are rejected under 35 U.S.C. 102(e) as being anticipated by Arsenault et al.

Referring to claims **1, 11, and 31**, Arsenault et al. discloses a method/medium/system comprising:

- receiving content and an advertisement (col. 17, l. 53-67; col. 18, l. 1-19; & Fig. 8);
- storing said content, including an interruptible content portion, and advertisement in a cache coupled to said receiver (col. 17, l. 53-67; col. 18, l. 1-19; & Fig. 8);
- analyzing the content to identify a location to insert the advertisement within the content and, based on said analysis (col. 18, l. 1-5), finding a place to insert said advertisement (164, 168) in said portion while said portion is still stored in said cache (col. 18, l. 1-19 & Fig. 8);
- inserting said advertisement in said portion (Fig. 8); and
- outputting for display (164, 168) said portion with said inserted advertisement (Fig. 8).



Art Unit: 2424

Referring to claims **2** and **12**, Arsenault et al. discloses the method/medium of claims 1 and 11, respectively, including receiving said content over a broadband distribution system (col. 3, l. 36-43 & col. 4, l. 3-6).

Referring to claims **3** and **13**, Arsenault et al. discloses the method/medium of claims 2 and 12, respectively, including receiving television programming (col. 3, l. 36-38 & col. 4, l. 65-67).

Referring to claims **6**, **15**, and **37**, Arsenault et al. discloses the method/medium/system of claims 1, 11, and 31, respectively, including a tuner that tunes to a digital channel and demodulates said content and advertisement (col. 9, l. 34-40, 63-64 & Fig. 3).

Referring to claims **7**, **16**, and **38**, Arsenault et al. discloses the method/medium/system of claims 6, 15, and 31, respectively, including parsing said content and said advertisement from control information (col. 5, l. 20-29; col. 9, l. 63-67; & col. 10, l. 1-10).

Referring to claims **10**, **19**, and **40**, Arsenault et al. discloses the method/medium/system of claims 1, 11, and 31, respectively, including receiving encrypted content and a shell controlling the decryption of said content to prevent theft of said content (col. 15, l. 1-11).

Referring to claim **32**, Arsenault et al. discloses the system of claim 31, wherein said system is a television receiver (Fig. 3).

Referring to claim **42**, Arsenault et al. discloses the system of claim 31, wherein said shell is coupled to said cache to allow the use of the content received by said receiver, automatically interrupt the use of the content, and temporarily replace the content with the advertisement (col. 18, l. 1-19 & Figs. 3, 8).

Art Unit: 2424

Referring to claim **43**, Arsenault et al. discloses the system of claim 31, wherein said cache is an encrypted cache (the data is stored in an encrypted MPEG format)(col. 10, l. 11-24).

Referring to claim **46**, Arsenault et al. discloses the method of claim 1, including displaying content information with said advertisement (Fig. 8).

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims **4, 8, 9, 14, 17, 18, 33-36, 39, 41** are rejected under 35 U.S.C. 103(a) as being unpatentable over Arsenault et al. in view of Zigmond et al.

Referring to claims **4, 14, and 36**, Arsenault et al. discloses the method/medium/system of claims 1, 11, and 31, respectively, wherein inserting the advertisement in said portion includes a shell that replaces at least part of said content with the advertisement (col. 18, l. 1-19 & Fig. 8). Arsenault et al. does not specifically disclose periodically replacing content with a single ad. Zigmond et al. discloses a system and method for selecting and inserting advertisements into a video programming feed at the household level (see Abstract). Zigmond et al. further discloses inserting the same ad into content multiple times (col. 13, l. 40-45). It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify Arsenault et al. to insert the same advertisement multiple times, such as that taught by Zigmond et al. in order

Art Unit: 2424

to provide an improved system for directing television advertisements to interested viewers (Zigmond et al. col. 3, l. 62-64).

Referring to claims **8**, **17**, **34**, and **39**, Arsenault et al. discloses the method/medium/system of claims 7, 16, and 31. Arsenault et al. does not disclose that parsing content from control information includes parsing from said content, instructions for determining when said content may be interrupted. Zigmond et al. discloses a system and method for selecting and inserting advertisements into a video programming feed at the household level (see Abstract). Zigmond et al. further discloses inserting the advertisements at an appropriate time based on a triggering event, which may be a time specified by encoded data in the video programming feed (col. 4, l. 40-43; col. 7, l. 26-29; & col. 17, l. 21-31). It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify Arsenault et al. to encode a time for inserting advertisements into the video programming, such as that taught by Zigmond et al. in order to provide an improved system for directing television advertisements to interested viewers (Zigmond et al. col. 3, l. 62-64).

Referring to claims **9**, **18**, and **33**, Arsenault et al. discloses the method/medium/system of claims 7, 16, and 31, respectively. Arsenault et al. does not disclose receiving instructions from a back channel for controlling the interruption of said content. Zigmond et al. discloses a system and method for selecting and inserting advertisements into a video programming feed at the household level (see Abstract). Zigmond et al. further discloses delivering ad selection rules over telephone or downloading them from the World Wide Web (col. 11, l. 66-67 & col. 12, l. 1-9). The ad selection rules match the viewer with the advertisements to efficiently target desired viewers of particular advertisements (col. 11, l. 43-49). It would have been obvious to one of

Art Unit: 2424

ordinary skill in the art at the time that the invention was made to modify Arsenault et al. to include receiving ad selection rules over telephone or from the World Wide Web, such as that taught by Zigmond et al. in order to provide an improved system for directing television advertisements to interested viewers (Zigmond et al. col. 3, l. 62-64).

Referring to claim **35**, the combination of Arsenault et al. and Zigmond et al. teaches the system of claim 34, wherein said device also parses instructions for how to store said content and said advertisement (Arsenault et al. col. 15, l. 1-11 & col. 18, l. 1-19).

Referring to claim **41**, the combination of Arsenault et al. and Zigmond et al. teaches the system of claim 35, including content guide software to receive interruption instructions for interrupting said content and replacing it with said advertisement (see claim 8 above)(Zigmond et al. col. 17, l. 21-31).

3. Claims **44**, **45**, **47** are rejected under 35 U.S.C. 103(a) as being unpatentable over Arsenault et al. in view of Armstrong et al.

Referring to claims **44**, **45**, and **47**, Arsenault et al. discloses the method of claim 1. Arsenault et al. does not disclose that the finding includes detecting that a user paused using said content, and retrieving said advertisement from said cache when it is detected that said user paused using said content. Arsenault et al. further does not disclose that the detecting includes detecting that the user temporarily stopped using the content. Arsenault et al. still further does not disclose inserting said advertisement in response to a pause in the display of said content. Armstrong et al. discloses presenting advertisements to a user in response to the user pausing video-on-demand content (col. 2, l. 14-22, 63-67; col. 3, l. 1-3; & Fig. 4). It would have been

Art Unit: 2424

obvious to one of ordinary skill in the art at the time that the invention was made to modify the ad insertion of Arsenault et al. to include inserting advertisements in response to a user pausing content, such as that taught by Armstrong et al. in order to put “freeze frame” or other similar display imagery to greater uses (Armstrong et al. col. 1, l. 63-67).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL VAN HANDEL whose telephone number is (571)272-5968. The examiner can normally be reached on 8:00am-5:30pm Mon.-Fri..

Art Unit: 2424

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on 571-272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Chris Kelley/  
Supervisory Patent Examiner, Art Unit  
2424

MVH